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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,991	03/02/2004	Mikhail Lotvin		1319

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EXAMINER

BOVEJA, NAMRATA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

10/790,991

Applicant(s)

LOTVIN ET AL.

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27, 28 and 63-75 is/are pending in the application.
- 4a) Of the above claim(s) 63-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 63-75 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/03/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 04/20/2006.
2. Claims 27 and 28 are presented for examination.
3. Amendments to the claims and drawings have been entered and considered.
4. Newly submitted claims 63-75 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
 - I. Claims 27 and 28 drawn to a method of sending e-mail containing advertising messages with an expiration date and monetary amount being indicated without displaying the entire advertisement and transferring monetary value to an account of the user, classified in class 705, subclass 14.
 - II. Claims 63-70, drawn to a method of sending e-mail containing advertising messages with an expiration date wherein only a first portion of the advertisement is initially displayed and identifies information for a second portion which is then displayed in response to a user action, classified in class 705, subclass 26.
 - III. Claims 71-75, drawn to a method of providing advertisement to a second user including enabling the first user to access an account and identify a group of advertisements for display to the second user in association with the first user's account and enabling the

second user to access the content through the first computer system, classified in class 705, subclass 35.

5. Inventions of group I and groups II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group I has separate utility such as sending an e-mail with advertising messages without displaying the entire advertisement, which does not involve only displaying a first portion of the advertisement initially that identifies information for a second portion and then displaying the second portion in response to a user action. See MPEP § 806.05(d).

6. Inventions of groups I and group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of group III has separate utility such as enabling the first user to access an account and identify a group of advertisements for display to the second user in association with the first user's account and enabling the second user to access the content through the first computer system, which does not involve sending e-mail containing advertising messages with an expiration date and monetary amount being indicated without displaying the entire advertisement and transferring monetary value to an account of the user. See MPEP § 806.05(d).

7. Inventions of groups II and group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are

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distinct from each other if they are shown to be separately usable. In the instant case, the invention of group II has separate utility such as sending e-mail containing advertising messages with an expiration date wherein only a first portion of the advertisement is initially displayed and identifies information for a second portion which is then displayed in response to a user action, which does not involve providing advertisement to a second user including enabling the first user to access an account and identify a group of advertisements for display to the second user in association with the first user's account and enabling the second user to access the content through the first computer. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 63-75 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

8. Upon further review, the Examiner has determined that for claims 27 and 28, Applicant's claim to priority back to 09/329,143, which is 06/09/1999, is valid since the specification for these related applications does provide the necessary

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support for the disclosure and the claims presented in this case. Therefore, claims 27 and 28 will be given the filing date of 06/09/1999.

Claim Rejections - 35 USC § 112

9. *The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, since the recitation that the monetary value is displayed without displaying the entire advertisement renders the claim indefinite, because it is unclear what the Applicant means by entire advertisement. It could mean that half of the advertisement is showed, or the first word of the advertisement is shown, or just text and no graphics are shown etc. It is interpreted to mean that a high level tag line about the advertisement is shown first before showing the user the specific information for a given advertisement. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 27 and 28 are rejected under U.S.C. 103(a) as being unpatentable over (*article by Becker titled "Advertising and Marketing; Paid Per View; Online Marketers Are Rewarding Users Just for Looking at Ads" hereinafter Becker*) in view of *Valupage.com website (www.valupage.com) (from date 05/30/1998 captured by the Wayback Machine Internet Archives) hereinafter Valupage.*

Disclaimer: Claim 27 was found to be deficient under U.S.C. 112 second. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 27, *Becker* teaches a method of providing advertisement to a user communicating with an advertising entity over a network, comprising: sending e-mail containing advertisement message specifying a monetary value associated with the message (*i.e. user receives credits for receiving, reading, and responding to e-mail messages containing advertisements*) (*page 2 paragraph 6*); receiving a response from the user indicating that the user has opened the e-mail (*i.e. user has to identify a secret word buried in the message after the user opens the e-mail in order to receive points associated with opening the e-mail*) (*page 2 paragraph 6*).

Becker teaches the users earning credits that can be redeemed for gift certificates, frequent-flier miles, credit card payments, and discounts (*page 1 paragraph 2, page 2 paragraphs 4 and 6, and page 3 paragraph 10*). *Becker*

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does not specifically teach transferring the monetary value specified in the e-mail to an account of the user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer the monetary value specified in the e-mail as taught by Becker to an account of the user, since it was known in the art that a user account can be used to store credits for redemption of the credits for prizes and discounts and to keep track of all the credits the user was accumulating for performing different activities.

Becker is silent about displaying the monetary value without displaying the entire advertisement. Valupage teaches displaying the monetary value without displaying the entire advertisement (i.e. the user knows that he may be eligible to save over \$36.00 on this week's ValuPage, but the user does not find out the specifics of the advertisement such as discount on a specific product until the user submits a zip code) (see ValuPage print out lines 4-9). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include displaying the monetary value without displaying the entire advertisement to motivate the user to perform additional steps such as download a video game before more reward credits are provided to the user. And, even though the ValuPage invention is depicted as being carried out on a website in the printed embodiment, it could have easily been pasted in the body of the e-mail message itself.

11. In reference to claim 28, Becker teaches the users earning credits that can be redeemed for gift certificates, frequent-flier miles, credit card payments, and discounts (page 1 paragraph 2, page 2 paragraphs 4 and 6, and page 3

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paragraph 10). Becker does not specifically teach transferring the monetary value specified in the e-mail to an account of the user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer the monetary value specified in the e-mail as taught by Becker to an account of the user, since it was known in the art that a user account can be used to store credits for redemption of the credits for prizes and discounts and to keep track of all the credits the user was accumulating for performing different activities.

Becker is silent about the method further comprising specifying an expiration date after opening the e-mail. ValuPage teaches specifying an expiration date (i.e. the savings are just for this week) (see ValuPage print out lines 8 and 9). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include an expiration date for the advertising messages to encourage the user to quickly redeem the offer and to maintain an accurate record of how many credits have been rewarded for a given campaign during a specific time period. And, even though the ValuPage invention is depicted as being carried out on a website in the printed embodiment, it could have easily been pasted in the body of the e-mail message itself.

Response to Arguments

12. After careful review of Applicant's remarks/arguments filed on 04/20/2006, the Applicant's arguments with respect to claims 27 and 28 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments

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to claims 27 and 28 have been entered and considered.

Newly added claims 63-75 have not been considered. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 63-75 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

13. Applicant's claim to priority back to 09/329,143, for the date of 06/09/1999, for claims 27 and 28 is valid, since upon further review, the specification for this related application does provide the necessary support for the disclosure and the claims presented in this case.

14. In reference to claims 27 and 28, the Applicant argues that the use of Official Notices is unsubstantiated. The Applicant further states that official notices in the Office Action, provided without any documentary support are improper and Applicants object to such official notices and that the facts cited in the official notices are not of common knowledge capable of instant and unquestionable demonstration. With respect to this, the Examiner would like to point out that the Applicant has not presented arguments that the features are not well known. The Applicant's only argument has been that the Examiner fails to establish that the claimed elements would be old and well known. This does not constitute a proper challenge to the Official Notice, since the Applicant has not said anything regarding that the Applicant was not aware that the claimed elements were well known before the filing of his application and before his

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invention was developed. Per the Applicant's citing of MPEP 2144.03, "A seasonable challenge constitutes a demand for evidence be made as soon as practicable during prosecution. Thus the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well-known statements. In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the Applicant has not challenged the correctness of the assertions but rather only the use of Official Notice itself. Bald statements such as "the use of Official Notices is unsubstantiated" and that "the Official Notices in the Office Action provided without any documentary support, are improper, and Applicants object to such Official Notices" are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on part of the Examiner to use it in the process of establishing a rejection of notoriously well known facts (*In re Boon*, 169 USP 231 (CCPA 1971). Furthermore, the Examiner had previously cited two examples of signing up for a rewards program and printed coupons that specify an expiration date to support the Official Notice. Specifically, when a user signs up to be a member of a rewards program that gives rewards and credits for reading e-mails, the user learns about the credit structure of the rewards program. For example, in

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Becker, the user knows that he will receive 25 credits for receiving the messages (i.e. before he ever reads the messages) as part of signing up for the rewards program. Additionally, point of sales coupons and web based offers such as those offered by ValuPage utilize expiration dates after which the incentives are no longer valid. Therefore, the Official Notice was proper and fully supported by the indicated evidence and is maintained.

15. Applicants additional remarks addressed to the new claim limitations have been addressed in the rejection necessitated by the amendments.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) "Internet coupons could be filling electronic mailboxes." The Wall Street Journal. June 21, 1998. Page F.11. (Teaches ValuPage's ValuE-mail offering that e-mails the offers presented on the website to the users weekly.)
- b) ValuPage website printout regarding Supermarket Coupons.
<http://web.archive.org/web/19981203014547/http://www.valupage.com/> December 2, 1998.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the

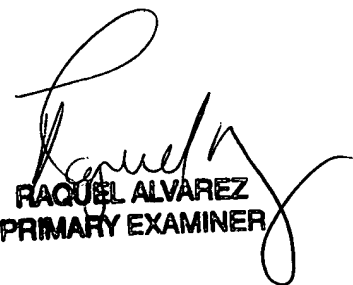
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examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197.



NB

August 3rd, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER